

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Re Application of: Jens Jacobsen et al.

Serial No.: 10/516,870

Examiner: Godbold, Douglas

Filing Date: August 25, 2005

Group Art Unit: 2626

Title: **Voice-controlled data access in and control of a mobile communication device via speech recognition**

MAIL STOP APPEAL BRIEFS-PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This reply brief, prepared under 37 C.F.R. 41.37 effective September 13, 2004, follows a Notice of Appeal filed on July 29, 2009 and Appeal Brief filed on October 8, 2009 in response to a final Office Action mailed May 29, 2009, and an Examiner's Answer issued January 8, 2010.

I. STATUS OF CLAIMS

The application has 32 claims, in which claims 2, 7, 8, 11 and 18 are canceled, and claims 1, 3-6, 9, 10, 12-17 and 19-32 are pending. In the final Office Action of May 29, 2009 and the Examiner's Answer of January 8, 2010, claims 1, 3-6, 9, 10, 12-17 and 19-32 were rejected.

Rejections to claims 1, 3-6, 9, 10, 12-17 and 19-32 are being appealed.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are to be reviewed on appeal:

Claims 1, 3-6, 9, 10, 12-17 and 19-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Fortier et al (U.S. Patent No. 6,584,179, Fortier hereinafter) in view of Badarneh (U.S. Publication 2003/0001816, Badarneh hereinafter) and further in view of Smith et al (U.S. Publication 2001/0047263, Smith hereinafter) - page 2 of the final Office Action, May 29, 2009.

III. ARGUMENT

At page 3 of the Examiner’s Answer of January 8, 2010 (hereinafter “Examiner’s Answer”), the Office maintains the rejections of claims 1, 3-6, 9, 10, 12-17 and 19-32 set forth in the final Office Action of May 29, 2009. Applicant maintains the arguments set forth in Applicant’s Appeal Brief of October 8, 2009 (hereinafter “Appeal Brief”). However, in response to the Appeal Brief, the Office raises several issues in the Response to Arguments section of the Examiner’s Answer on page 17, that Applicant shall address further.

Claim 1

With respect to claim 1, it is stated:

The examiner agrees with the Appellant’s summary of the workings of Fortier, and that these operations are different than as described in the Appellant’s specification. However, these differences are not clear in the claims. There is nothing in the claims that suggest that the speech recognition must be performed at the mobile device, leaving open the possibility of sending speech data to a server for processing as described in Fortier.

Applicant respectfully disagrees with the argument that claim 1 does not suggest that the speech recognition must be performed at the mobile device. Claim 1 recites: “receiving an initial user input causing a mobile communication device to be prepared for receiving an acoustic input of the user to perform speech recognition thereon; receiving said acoustic input of the user and performing speech recognition thereon.” When these two elements of claim 1 are read in combination, it would lead anyone to understand the claim as reciting that the mobile communication device receives the acoustic input of the user and performs speech recognition. It is explicitly stated that receiving an initial input causes the mobile communication device to be prepared for receiving an acoustic input and performing speech recognition thereon. If the claimed feature of “receiving said acoustic input of the user and performing speech recognition thereon” is performed by a server, as is

suggested by the Office, then it would render the first feature of the claim superfluous. If the claim is interpreted such that mobile communication device is not receiving the acoustic input and not performing speech recognition, then the claimed feature of receiving an initial user input causing the mobile communication device to be prepared for receiving the acoustic input and performing speech recognition would lose significance in the claim. There would not be a reason to prepare the mobile device for receiving the acoustic input and performing speech recognition if a server does this receiving and performing, not the mobile device. The Office's interpretation of claim 1 requires not giving each term in the claim meaning and would render other words and phrases in the claim superfluous, an approach which has been deemed improper by the Federal Circuit Court of Appeals.¹

Therefore, Applicant respectfully submits that claim 1 suggests that speech recognition must be performed at the mobile device, thereby distinguishing claim 1 from Fortier for the reasons provided by Applicant in the Appeal Brief at pages 7-9, in addition to those reasons provided above.

It is further stated at page 18 of the Examiner's Answer with respect to claim 1 that the fact that Fortier does most of its processing on a server and Badarneh operates on a mobile device does not affect the obviousness of the combination, and that performing speech recognition on a server or performing it on the mobile device is a matter of design choice. Applicant respectfully disagrees. As mentioned from page 1, lines 11-27 of Applicant's application as filed (WO 2004/006550), performing speech recognition in the mobile device itself provides significant functional advantages over other systems, such as the one found in Fortier. In Fortier, a display telephone is connected by an analog line to a public switched telephone network, which is further connected to one or more access servers capable of querying speech recognition algorithms in order to convert words spoken by

¹ See, e.g., Merck & Co. v. Teva Pharmaceuticals USA, Inc. 395 F.3d 1364, 1372, 73 U.S.P.Q.2d 1641, 1648 (Fed. Cir. 2005) (stating "A claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so").

subscribers using the display telephone into one or more representations of the spoken word (Fortier, Figure 1; column 4, lines 25-50). The present invention's use of speech recognition in a mobile communication device presents significant structural and functional distinctions and advantages from the system of Fortier that extend beyond mere difference in design choice. Therefore, for these reasons, in addition to those reasons set forth in the Appeal Brief at pages 9-10, Applicant respectfully submits that the combination of Fortier and Badarneh is not obvious and fail to disclose the invention of claim 1.

Lastly, at page 19 of the Examiner's Answer, it is asserted with respect to claim 1 and in response to Applicant's arguments appearing on pages 10-11 of the Appeal Brief that:

The Appellant points out that Smith allows voice dialing and points out that this function is different than the functions described in the specification, where the functions may not include voice dialing. However, it is noted that this distinction fails to appear in the claims. Even if the claims could be interpreted as being distinct from voice dialing functions, Smith at least suggests voice commands for other functions, as at step 635 on Figure 6, a user may state "directory" which appears to be similar to a Missed calls list that the applicant gives as an example on page 13 in the application as originally filed.

Applicant respectfully disagrees with these assertions. The Office cites Smith at pages 6-7 of the Examiner's Answer as teaching "allowing the user to navigate commands with speech recognition" so as to teach or suggest the claimed features of wherein said second set of data records represents all device functions or device application functions, or both, associated with voice tags and controllable by speech recognition. Claim 1 recites that "data records of said first set of data records each comprise at least one instruction dedicated to a dialing application for dialing a telephone number comprised in said instruction" and "data records of said second set of data records each comprise at least one instruction dedicated to a control function of at least one further application executed on said mobile communication device in

accordance with said instruction.” The claim therefore recites that it is the first set of data records that includes the instruction to dial a telephone number, not the second set of data records. Thus, contrary to the Office’s assertion, the distinction set forth by Applicant in the Appeal Brief between the second set of data records of claim 1 and Smith, appears in claim 1.

In addition, Figure 6 of Smith, particularly “directory” (Step 635) does not disclose the claimed feature of “wherein said second set of data records represents all device functions or device application functions, or both, associated with voice tags and controllable by speech recognition.” Smith describes the “directory” option as “reviewing or maintaining a directory of potential called parties” (Smith, paragraph [0057]). Smith further discloses “the system displays a list stored in the directory from which the user may select a location to call the party” and the method of the invention involves “searching the directory for the specific name and calling a number associated with the specific name in the directory” (Smith, paragraph [0069], claim 18). Thus, the directory of Figure 6 in Smith does not relate to the second set of data records, but rather it also relates to the claimed first set of data records representing all telephone directory entries and comprising at least one instruction dedicated to a dialing application for dialing a telephone. Thus, the directory is not suggestive of the second set of data records, or for example, the missed calls operation S220 cited by Applicant at page 11 of the Appeal Brief.

Therefore, for the above reasons in addition to those provided at pages 10-11 of the Appeal Brief, it is respectfully submitted that Smith does not teach or suggest wherein the second set of data records represents all device functions or device application functions, or both, associated with voice tags and controllable by speech recognition.

In view of the above arguments and those provided by Applicant in the Appeal Brief, it is respectfully submitted that the invention of claim 1 is not rendered obvious by Fortier in view of Badarneh, further in view of Smith.

Claims 3-6

With respect to claims 3-6, Applicant maintains those arguments presented for these claims in the Appeal Brief at page 11, and respectfully submits that they are not rendered obvious by Fortier in view of Badarneh, further in view of Smith, at least in view of their dependencies on claim 1.

Claim 9

In pages 19-21 of the Examiner's Answer in the Response to Arguments section, in reference to independent claim 9, the Office repeats the same response arguments provided for independent claim 1 that are described above. Because Applicants arguments pertaining to claim 1 set forth above, apply equally to independent claim 9 in response to the new arguments presented by the Office in the Examiner's Answer, Applicant maintains those arguments for independent claim 9, and also maintains the arguments presented with respect to these claims in the Appeal Brief at page 11. Therefore, it is respectfully submitted that the invention of independent claim 9 is not rendered obvious by Fortier in view of Badarneh, further in view of Smith.

Claim 10

In pages 22-24 of the Examiner's Answer in the Response to Arguments section, in reference to independent claim 10, the Office repeats the same response arguments provided for independent claim 1 that are described above. Because Applicants arguments pertaining to claim 1 set forth above, apply equally to independent claim 10 in response to the new arguments presented by the Office in the Examiner's Answer, Applicant maintains those arguments for independent claim 10, and also maintains the arguments presented with respect to this claim in the Appeal Brief at pages 11-12. Therefore, it is respectfully submitted that the invention of

independent claim 10 is not rendered obvious by Fortier in view of Badarneh, further in view of Smith.

Claims 12-16 and 25-28

With respect to claims 12-16 and 25-28, Applicant maintains those arguments presented for these claims in the Appeal Brief at page 12, and respectfully submits that they are not rendered obvious by Fortier in view of Badarneh, further in view of Smith, at least in view of their dependencies on claim 10.

Claim 17

In pages 24-26 of the Examiner's Answer in the Response to Arguments section, in reference to independent claim 17, the Office repeats the same response arguments provided for independent claim 1 that are described above. Because Applicants arguments pertaining to claim 1 set forth above, apply equally to independent claim 17 in response to the new arguments presented by the Office in the Examiner's Answer, Applicant maintains those arguments for independent claim 17, and also maintains the arguments presented with respect to this claim in the Appeal Brief at page 12. Therefore, it is respectfully submitted that the invention of independent claim 17 is not rendered obvious by Fortier in view of Badarneh, further in view of Smith.

Claims 19-24 and 29-32

With respect to claims 19-24 and 29-32, Applicant maintains those arguments presented for these claims in the Appeal Brief at page 12, and respectfully submits that they are not rendered obvious by Fortier in view of Badarneh, further in view of Smith, at least in view of their dependencies on claim 17.

For the reasons discussed above and in Applicant's Appeal Brief, Applicant respectfully submits that the rejection in the final Office Action of May 29, 2009, repeated in the Examiner's Answer, is clearly improper, and the claimed invention should be allowed for a patent. The applicant respectfully requests that the Board withdraw the rejection to claims 1, 3-6, 9, 10, 12-17 and 19-32.

Respectfully submitted,

/Francis J. Maguire/

Francis J. Maguire
Attorney for the Applicant
Registration No. 31,391

WARE, FRESSOLA, VAN DER SLUYS
& ADOLPHSON LLP
755 Main Street, P.O. Box 224
Monroe, Connecticut 06468
(203) 261-1234